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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,162	09/08/2003	Paul F. Finnigan	27853.004.22	1317

7590

09/28/2006

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EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,162

Applicant(s)

FINNIGAN, PAUL F.

Examiner

Gerald Gauthier

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/19/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed July 19, 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because a US patent has been placed in the foreign patent list. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title; if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. **Claim(s) 19-51** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weare et al. (US 5,909,483) in view of Arbel et al. (US 5,276,731).

Regarding **claim(s) 19 and 31**, Weare discloses a method of controlling transmission of message data from a sender having an origination address to a recipient having a first destination address (FIG. 1 and column 1, lines 17-23), comprising:

the recipient providing at least one specific instruction from a plurality of instructions for storage in a storage medium for controlling the transmission of the message data directed to the first destination address (column 5, lines 17-29);

determining whether the at least one specific instruction provided by the recipient corresponds to the first destination address (column 5, lines 17-29); and

Weare fails to disclose processing the message according to a recipient instruction and the sender delivery command.

However, Arbel teaches processing the message data in accordance with the at least one specific instruction provided by the recipient for controlling the transmission of message data directed to the destination address when the at least one specific instruction corresponds to the destination address of the transmitted electronic data, wherein the plurality of instructions includes transmitting the message data to a second destination address, the second destination address being different from the first destination address (column 8, lines 6-55).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Weare using the teaching of a profile database as taught by Arbel.

This modification of the invention enables the system to process the message according to a recipient instruction and the sender delivery command so that the user would receive the message at the selected destination.

Regarding **claim(s) 20 and 39**, Weare discloses a method, further comprising transmitting the message data only if the origination address is included in a pre-selected set of acceptable origination addresses (column 6, lines 27-34).

Regarding **claim(s) 21 and 40**, Weare discloses a method, further comprising blocking transmission of the message data when the origination address is included in a pre-selected set (column 6, lines 27-34).

Regarding **claim(s) 22 and 41**, Weare discloses a method, further comprising assigning the message data a delivery priority for establishing priority for retrieval by the recipient of the message data from the first destination address when the origination address is included in a pre-selected set (column 6, line 27-34).

Regarding **claim(s) 23 and 42**, Weare discloses a method, further comprising prohibiting the electronic data from being copied or forwarded in the at least one specific instruction (column 6, lines 20-27).

Regarding **claim(s) 24 and 43**, Weare discloses a method, wherein the sender and the recipient each have an assigned user mailbox (column 6, lines 27-34).

Regarding **claim(s) 25 and 44**, Weare discloses a method, wherein the first destination address is a user mailbox (column 6, lines 20-34).

Regarding **claim(s) 26 and 45**, Weare discloses a method, wherein the electronic data includes text data (column 8, line 64 to column 9, line 3).

Regarding **claim(s) 27 and 46**, Weare discloses a method, wherein the text data is delivered to an electronic document system (column 8, line 64 to column 9, line 3).

Regarding **claim(s) 28 and 47**, Weare discloses a method, wherein the electronic document system includes an electronic mail system or a facsimile document system (column 8, line 64 to column 9, line 3).

Regarding **claim(s) 29 and 48**, Weare discloses a method, wherein the electronic data includes voice data (column 8, line 64 to column 9, line 3).

Regarding **claim(s) 30 and 49**, Weare discloses a method, wherein the voice data is delivered to a voice message system (column 7, lines 10-25).

Regarding **claim(s) 32**, Weare discloses a method, wherein the electronic message is converted from voice (column 8, line 64 to column 9, line 3).

Regarding **claim(s) 33**, Weare discloses a method, wherein the at least one specific instruction is received from the recipient (column 7, lines 10-25).

Regarding **claim(s) 34**, Weare discloses a method, wherein the at least one specific instruction is received from the sender (column 7, lines 10-25).

Regarding **claim(s) 35**, Weare discloses a method, wherein the at least one specific instruction includes converting a voice instruction, wherein the voice instruction comprises at least one command (column 7, lines 10-25).

Regarding **claim(s) 36**, Weare discloses a method, wherein the at least one specific instruction includes converting a voice instruction, wherein the voice instruction comprises at least one acceptance code (column 7, lines 10-25).

Regarding **claim(s) 37**, Weare discloses a method, wherein the at least one specific instruction includes receiving at least one command entered from a personal computer (column 8, lines 1-14).

Regarding **claim(s) 38**, Weare discloses a method, wherein the at least one specific instruction includes receiving at least one acceptance code entered from a personal computer (column 8, lines 1-14).

Regarding **claim(s) 50 and 51**, Arbel teaches a method, wherein the at least one specific instruction of the recipient over-rides an instruction of the sender (column 8, lines 6-55).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Weare using the teaching of a profile database as taught by Arbel.

This modification of the invention enables the system to process at least one specific instruction of the recipient over-rides an instruction of the sender so that the user would receive the message at the selected destination.

Response to Arguments

5. Applicant's arguments with respect to **claim(s) 19-51** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


GERALD GAUTHIER
PATENT EXAMINER

Gerald Gauthier
Examiner
Art Unit 2614

GG
September 22, 2006